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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/008,488	11/05/2001	Siegfried K. Holz	2497.0020000/MBR/MWR	5623

26111 7590 05/05/2008
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EXAMINER

COBANOGLU, DILEK B

ART UNIT	PAPER NUMBER
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3626

MAIL DATE	DELIVERY MODE
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05/05/2008

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/008,488	Applicant(s) HOLZ, SIEGFRIED K.	
	Examiner DILEK B. COBANOGLU	Art Unit 3626	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 28 February 2008.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 2-5 and 9 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 2-5 and 9 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>11/05/2001, 3/20/2003</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 2/28/008 has been entered.

Specification

New Matter

2. The amendment filed 2/28/2008 is objected to under 35 U.S.C. 132(a) because it introduces new matter into the disclosure. 35 U.S.C. 132(a) states that no amendment shall introduce new matter into the disclosure of the invention. The added material which is not supported by the original disclosure is as follows: if a denial is received then the computer system automatically commences an automatic feedback loop of transmitting a prescription fulfillment request for the medication prescription to a next preferred pharmacy, wherein the next preferred pharmacy is selected from the list of preferred pharmacies on the stored memory, until a prescription fulfillment confirmation is received by the computer system at the physician's office. In particular, Applicant does not point to, nor was the Examiner able to find, any support for this limitation.
3. Applicant is required to cancel the new matter in the reply to this Office Action.

Claim Rejections - 35 USC § 112

4. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

5. Claims 2-5 and 9 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. The amended claims 2, 3, and 9 recite “if a denial is received then the computer system automatically commences an automatic feedback loop of transmitting a prescription fulfillment request for the medication prescription to a next preferred pharmacy, wherein the next preferred pharmacy is selected from the list of preferred pharmacies on the stored memory, until a prescription fulfillment confirmation is received by the computer system at the physician's office”.

This limitation is not described in the originally filed claims or in specification. The originally filed specification recites: par. [0033] “The host server 24 will then establish Internet connection with a preselected pharmacy 26 from the updated stored memory on the PMC at 50. The pharmacy 26 will then check and confirm prescription inventory at 52 and will either confirm the fulfillment request or decline the request due to unavailability of the medication ordered. Once a pharmacy 26 has confirmed fulfillment, the host server 24 will advise of prescription fulfillment and the details and location of the pharmacy at 54 to the doctor's office computer 22. As soon as the doctor's office

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computer 22 receives prescription fulfillment confirmation, the PMC will be returned to the patient 28 at 56 to complete the patient's office visit." Neither the specification nor the originally filed claims recite if a pharmacy declines the prescription fulfillment requirement then the system automatically commences an automatic feedback loop of transmitting a prescription fulfillment request for the medication prescription to a next preferred pharmacy, wherein the next preferred pharmacy is selected from the list of preferred pharmacies on the stored memory, until a prescription fulfillment confirmation is received by the computer system at the physician's office.

6. Claims 4-5 incorporate the deficiencies of independent claim 3, through dependency, and are also rejected.

Claim Rejections - 35 USC § 103

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

NOTE: The following rejections assume that the subject matter added in 2/28/2008 amendment are NOT new matter, and are provided hereinbelow for Applicant's consideration, on the condition that Applicant properly traverses the new matter objections and rejections made in sections 2-6 above in the next communication sent in response to the present Office Action.

8. Claims 2-5 are rejected under 35 U.S.C. 103(a) as being unpatentable over Joao (U.S. Patent No. 6,283,761 B1), McCormick (U.S. Patent Application No. 2002/0035484) and further in view of Official Notice.

A. Claim 2 has been amended now to recite a method of transmitting a medication prescription fulfillment request from a physician's office, comprising the steps of:

- i. providing a patient with a personal memory card (PMC) having a stored memory (Joao; col. 7, lines 16-23, col. 39, line 54 to col. 40, line 2), modifying the stored memory to include a plurality of patient preferred pharmacies;
- ii. modifying said stored memory, while the patient is at the physician's office to include a medication prescription (Joao; col. 19, lines 12-20, 31-40, col. 39, line 54 to col. 40, line 2);
- iii. reading said stored memory of said PMC into a computer system in the physician's office (Joao; col. 15, line 59 to col. 16, line 18, col. 19, lines 12-20, 31-40, col. 40, lines 3-12);
- iv. receiving a prescription fulfillment confirmation or a prescription fulfillment denial (or notification) from the first preferred pharmacy (Joao; col. 31, line 66 to col. 32, line 45), wherein if a denial is received then the computer system automatically commences an automatic feedback loop of transmitting a prescription fulfillment request for the medication prescription to a next preferred pharmacy, wherein the next preferred

pharmacy is selected from the list of preferred pharmacies on the stored memory, until a prescription fulfillment confirmation is received by the computer system at the physician's office.

Joao fails to expressly teach a plurality of patient preferred pharmacies. However, this feature is well known in the art, as evidenced by McCormick.

In particular, McCormick discloses a plurality of patient preferred pharmacies (McCormick; paragraphs: 0054, 0090, 0095).

It would have been obvious to one having ordinary skill in the art at the time of the invention to include the aforementioned limitation as disclosed by McCormick with the motivation of to have patient conveniently fill prescriptions at a selected pharmacy (McCormick; paragraph: 0054).

Joao fails to expressly teach transmitting a prescription fulfillment request for the medication prescription contained within said stored memory to a first preferred pharmacy, wherein said first preferred pharmacy is selected from the plurality of preferred pharmacies in said stored memory. However, this feature is well known in the art, as evidenced by McCormick.

In particular, McCormick discloses transmitting a prescription fulfillment request for the medication prescription contained within said stored memory to a first preferred pharmacy, wherein said first

preferred pharmacy is selected from the plurality of preferred pharmacies in said stored memory (McCormick; paragraphs: 0054, 0090, 0095).

It would have been obvious to one having ordinary skill in the art at the time of the invention to include the aforementioned limitation as disclosed by McCormick with the motivation of to have patient conveniently fill prescriptions at a selected pharmacy (McCormick; paragraph: 0054).

Joao fails to expressly teach if a denial is received then the computer system automatically commences an automatic feedback loop of transmitting a prescription fulfillment request for the medication prescription to a next preferred pharmacy, wherein the next preferred pharmacy is selected from the list of preferred pharmacies on the stored memory, until a prescription fulfillment confirmation is received by the computer system at the physician's office. However, Examiner takes official notice that it was well known in the electronic shopping arts to automatically forward or transmit a merchandise (or prescription) request to another (or alternative) detailer (or pharmacy) until to find the requested merchandise in the inventory.

The motivation would have been to find an alternative place for the required merchandise in a short time in the case where it is not in the stock in the first preferred place.

B. As per claim 3, it is the system claim, which repeats the same limitations of claim 2, the corresponding method claim, as a collection of elements as opposed to a series of process steps. Since the teachings of Joao, McCormick and Official Notice disclose the underlying process steps that constitute the methods of claim 2, it is respectfully submitted that it provides the underlying structural elements that perform the steps as well. As such, the limitations of claim 3 are rejected for the same reasons given above for claims 2.

C. Claim 4 has been amended now to recite the system of claim 3 wherein:

- i. said PMC is programmed to also include insurer information (Joao; col. 16, lines 38-65, col. 19, lines 12-20, col. 39, line 54 to col. 60, line 2);
- ii. said computer system is programmed to also electronically transfer insurance information to an insurer of the patient (Joao; col. 16, lines 38-65, col. 19, lines 12-20, col. 39, line 54 to col. 60, line 2).

D. Claim 5 has been amended now to recite the method of claim 2, further comprising the steps of: electronically transmitting information regarding the medication prescription to an insurer of the patient (Joao; col. 16, lines 38-65, col. 19, lines 12-20, col. 39, line 54 to col. 60, line 2).

9. Claim 9 is rejected under 35 U.S.C. 103(a) as being unpatentable over McCormick (U.S. Patent Application No. 2002/0035484), Joao (U.S. Patent No. 6,283,761 B1) and further in view of Official Notice.

- A. Claim 9 has been amended now to recite a method comprising:
- i. storing data on a personal memory card (PMC), wherein said data includes a list of preferred pharmacies (McCormick; par.: 0054, 0095);
 - ii. inserting said PMC into a first PMC reader/writer (McCormick; par.: 0054, 0095);
 - iii. modifying said stored data to further include a medical prescription (McCormick; par.: 0054, 0095);
 - iv. withdrawing said PMC from the first PMC reader/writer (McCormick; par.: 0054, 0095);
 - v. inserting said PMC card into a second PMC reader/writer, wherein said second PMC reader/writer is coupled to a computer system, said computer system having a transmitter to deliver a prescription request to a pharmacy (McCormick; par.: 0071-0073);
 - vi. transmitting a prescription fulfillment request to a first pharmacy, wherein the first pharmacy is selected from the list of preferred pharmacies stored on the PMC (McCormick; par.: 0054, 0095);
 - vii. receiving a prescription fulfillment confirmation or denial from the first pharmacy, wherein if a denial is received then the computer system automatically commences an automatic feedback loop of transmitting a

prescription fulfillment request for the medication prescription to a next preferred pharmacy, wherein the next preferred pharmacy is selected from the list of preferred pharmacies stored on the PMC, until a prescription fulfillment confirmation is received by the computer system at the physician's office; and

viii. withdrawing the PMC from the second PMC reader/writer (McCormick; par.: 0071-0073).

McCormick fails to expressly teach receiving a prescription fulfillment confirmation or denial from the first pharmacy. However, this feature is well known in the art, as evidenced by Joao.

In particular, Joao discloses receiving a prescription fulfillment confirmation or denial (or notification) from the first pharmacy (Joao; col. 31, lines 31-45, col. 31, line 66 to col. 32, line 45).

It would have been obvious to one having ordinary skill in the art at the time of the invention to include the aforementioned limitation as disclosed by Joao with the motivation of identity of the existence and/or location of the respective supply (or medication) (Joao; col. 31, lines 31-45).

- The obviousness of modifying the teaching of McCormick (or Joao) to include if a denial is received then the computer system automatically commences an automatic feedback loop of transmitting a prescription fulfillment request for the medication

prescription to a next preferred pharmacy, wherein the next preferred pharmacy is selected from the list of preferred pharmacies stored on the PMC, until a prescription fulfillment confirmation is received by the computer system at the physician's office (as rejected by Official Notice) is as addressed above in the rejection of claim 2 and incorporated herein.

Response to Arguments

10. Applicant's arguments filed 2/28/2008 have been fully considered but they are not persuasive. Applicant's arguments will be addressed below in the order in which they appear.

11. In response to applicant's arguments against the references individually, one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986). In response to Applicant's argument about Joao does not teach "the pertinent information includes a plurality of patient preferred pharmacies" Examiner respectfully submits that Joao teaches "Any of the patients, users, providers, payers, and/or intermediaries, can be provided with identification and/or other cards with any and/or all pertinent data regarding the respective individual and/or party provided on the card."

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The identification card, in the preferred embodiment can contain a magnetic strip for storing any and/or all pertinent information, a "smart card" for storing information, and/or a bar code or bard codes for storing identification information as well as any other information described herein as being pertinent to the respective patient, user, provider, payer, and/or intermediary." In col. 39, line 66- col. 40, line 2. Joao does not expressly teach a list of preferred pharmacies, but as explained above in the rejection of claim 2, McCormick teaches "The doctor's terminal can display a map showing multiple pharmacies and the patient may be able to select one from the map" in paragraph 0054, therefore McCormick teaches a list of preferred pharmacies, Examiner considers that this could be e pertinent data for the patient and could be stored in Joao's identification card. The motivation to combine these two references would be to have patient conveniently fill prescriptions at a selected pharmacy.

12. The newly added limitation "if a denial is received (from a pharmacy) then the computer system automatically commences an automatic feedback loop of transmitting a prescription fulfillment request for the medication prescription to a next preferred pharmacy, wherein the next preferred pharmacy is selected from the list of preferred pharmacies stored on the PMC, until a prescription fulfillment confirmation is received by the computer system at the physician's office" has been rejected as being a new matter, which is not described in the originally filed specification and claims. And Examiner takes official notice to reject this limitation as explained above in the rejections of claims 2 and 9.

Conclusion

13. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. The cited but not used prior art teach "Delivery of medical services using electronic data communications 5619991 A, Method for mediating social and behavioral processes in medicine and business through an interactive telecommunications guidance system 5722418 A, Prescription creation system 5737539 A, Method using central epidemiological database 5911132 A, System for medication dispensing and integrated data management 20020032582, Apparatus, system and method for managing diagnostic information 20020040305, Automatic prescription drug dispenser 20030093181".

14. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Dilek B. Cobanoglu whose telephone number is 571-272-8295. The examiner can normally be reached on 8-4:30.

15. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, C. Luke Gilligan can be reached on 571-272-6770. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

16. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic

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Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/D. B. C./
Examiner, Art Unit 3626
5/2/2008

/Robert Morgan/
Primary Examiner, Art Unit 3626